

## **Remarks**

### **A. Status of the Specification**

The specification has been revised to correct a typographical error by replacing the term “colored” with “uncolored” at page 7, lines 17-18, of the English translated specification. Confirmation that this is a typographical error is confirmed in the specification at page 7, lines 14-16, and at page 3, line 27, to page 4, line 14.

The Abstract is revised per the Examiner’s suggestion. A clean copy of the Abstract is provided at Appendix A of this response. Therefore, Applicant requests that the objection to the specification be withdrawn.

### **B. Status of the Claims**

Claims 44, 56, and 60-61 are cancelled.

Claims 45-55 are revised to change their form and dependency to claim 63.

Claims 57 and 63 are amended to incorporate the subject matter of cancelled claims 44, 60, and 61.

Claim 62 is amended to change its dependency to claim 57.

Claims 67-71 are added. Non-limiting support for these claims can be found in originally filed claims 1-43.

Claims 45-55, 57-59, and 62-66 are pending, with claims 57-59, 62, and 67-71 being withdrawn from consideration at this time as being directed to a non-elected invention.

### **C. Restriction Requirement**

Applicant orally elected the Group I claims during a telephone conference between Mark Wilson and Examiner Patel on January 29, 2010. Applicant requests that the method claims be rejoined, as the composition and method claims both share a general inventive concept that has a special technical feature that is not disclosed by the cited art (see below arguments). Further, the

composition claims are believed to be allowable, which provides an additional ground for rejoining the Group II method claims.

**D. Indefiniteness Rejections**

Claims 54 and 63 are rejected for allegedly being indefinite under 35 U.S.C. § 112, second paragraph. Claim 54 is revised to exclude "type." Claim 63 is revised to no longer reference cancelled claim 44.

Applicant believes that the indefiniteness rejections are moot and requests that they be withdrawn.

**E. Anticipation Rejections**

Two separate anticipation rejections are presented by the Examiner. A summary of these rejections is provided below:

1. Claims 44-48, 50-51, 53, and 55 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by U.S. Patent 5,576,088 ("Ogawa") in view of Hawley's Condensed Chemical Dictionary, U.S. Patent 6,451,379 ("Tsao"), and U.S. Patent 5,989,378 ("Liu").
2. Claims 44-51 and 63-66 are rejected under 35 U.S.C. § 102(e) for allegedly being anticipated by U.S. Publication 2005/0196626 ("Knox") in view of Hawley's Condensed Chemical Dictionary.

With respect to the first rejection, Applicant submits that it is moot in view of the fact that independent claim 44 has been cancelled and dependent claims 45-48, 50-51, 53, and 55 depend from non-rejected claim 63. Therefore, Applicant requests that this rejection be withdrawn.

With respect to the second rejection, Applicant respectfully notes that Knox fails to disclose several aspects of claim 63. For instance, claim 63 states that the ophthalmic lens includes "a colored latex layer" that is applied to the "front main face and/or the rear main face" thereof.

By comparison, although the Examiner concedes that Knox does not expressly disclose a colored latex layer, such a layer would inherently be present. The following is the stated rationale to support this anticipation by inherency theory:

Although [Knox] does not expressly disclose the colored latex, but does disclose initial [un]colored latex and a pigment. Thus, the initial uncolored latex and a pigment when they are mixed with each other, colored latex comprising uncolored latex and a pigment is formed.

Action at page 9. Per the Examiner, the alleged pigment is colloidal silica (*i.e.*, SiO<sub>2</sub>) or titanium dioxide (*i.e.*, TiO<sub>2</sub>). *Id.* at page 8.

In order to maintain this position, the Examiner must show that Knox's initial uncolored latex/SiO<sub>2</sub> or TiO<sub>2</sub> mixture necessarily results in a colored latex layer. *See* MPEP § 2112 (IV) ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.") (underline in original) (citations omitted). Applicant respectfully submits that the Examiner cannot satisfy this high burden.

Indeed, a facial reading of Knox suggests that the Examiner's rational is incorrect and what is actually produced is a colorless latex:

Such small particle colloidal silicas are readily available, are essentially colorless and have refractive indices that permit their inclusion in compositions that **results in colorless, transparent coatings**.

Knox at paragraph [0095] (emphasis added). Therefore, the language in Knox suggests that the resulting coatings are "colorless." That is, Knox directly contradicts the Examiner's position that Knox's initial uncolored latex/SiO<sub>2</sub> or TiO<sub>2</sub> Knox's mixture necessarily results in a colored coating; rather, a person having ordinary skill in the art would more likely conclude that the necessary result of Knox's mixture is a "colorless, transparent coating." There is simply no

reason provided in Knox to suggest otherwise. In addition, it is well-known that incorporation of SiO<sub>2</sub> or TiO<sub>2</sub> into a material such as a latex does not necessarily result in a colored latex.

Further, Applicant submits that the Examiner is using hindsight analysis by improperly picking and choosing from various portions of Knox's disclosure in an attempt to support the anticipation rejection. The Examiner selects SiO<sub>2</sub> or TiO<sub>2</sub> particles amongst a relatively extensive list of particles (see paragraph [0086]) and combines the selected particles with the application of Knox's composition under a latex form rather than application of a composition comprising precursor monomers as described in paragraph [0146]. The Examiner built his anticipation analysis by using Applicant's claims as a roadmap. Stated another way, the examiner ignored the wide variety of possible combinations disclosed in Knox and settled on a combination that is neither emphasized in the specification nor part of an Example. It is well-settled that such "picking" and "choosing" from a reference, without guidance from the reference as to why the combination is desirable, is generally frowned upon:

The [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.

*In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also *Ex parte Garvey*, 41 U.S.P.Q. 583 (Pat & Trademark Office Bd. App. 1939). In *Ex parte Garvey* the applicant's claims were directed to a vulcanized product and corresponding methods of making the same. *Id.* at 583. The examiner rejected the invention for anticipation in view of the Dykstra Patent. Dykstra disclosed a compound that had several possible variations that could be made to it. *Id.* at 584. In finding no anticipation, the Board reasoned that "[w]hile the invention here claimed in its broader aspects is doubtless embraced within the speculative teachings of the references, we doubt if references...can be fairly applied in rejecting claims such as those on appeal where anticipation

can be found only by making one of a very great number of possible permutations which are covered by the reference disclosures.” *Id.* The Court further stated:

The likelihood of producing a composition such as here claimed from a disclosure such as shown by the Dykstra patent would be about the same as the likelihood of discovering the combination of a safe from a mere inspection of the dials thereof.  
*Id.*

Claim 63 also recites that “a coating composition comprising a swelling agent for the colored latex” is “deposited onto the colored latex layer.” Applicant’s specification provides the following definition for the phrase “composition comprising a swelling agent for the colored latex”:

As used herein, a “composition comprising a swelling agent for the colored latex” means any composition that can produce a swelling of at least 30%, preferably of at least 40%, more preferably of at least 50%, and even more preferably of about 60%, of a 1  $\mu$ m-thick latex layer, applied onto a neutral support such as a mineral glass plate, after a dipping time of 180 seconds at the ambient temperature (around 20°C) in the swelling composition.

Specification at page 7, lines 30-35.

The Examiner has not shown where in Knox Applicant’s claimed “composition comprising a swelling agent for the colored latex” is disclosed. As with anticipation by inherency, the Examiner also bears the burden of establishing a *prima facie* case of express anticipation, which has not been met.

Applicant requests that the current anticipation rejections be withdrawn for at least the above-stated reasons.

**F. Obviousness Rejections**

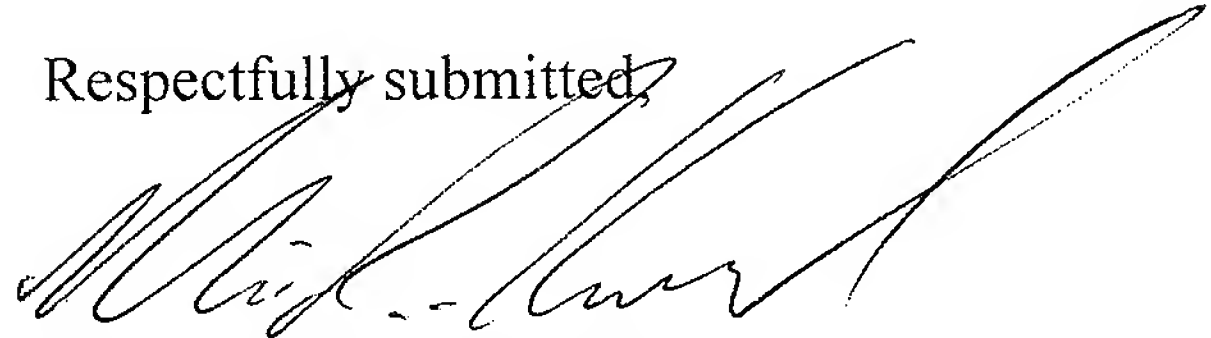
Dependent claims 52 and 54 are rejected under 35 U.S.C. § 103(a) in view of Ogawa and U.S. Publication 2004/0192807 ("Kim") or Ogawa, Kim, and U.S. Publication 2003/0169320 ("Tomotake"), respectively. The combination of Ogawa and Kim or Ogawa, Kim, and Tomotake fail to disclose or suggest every element of claims 52 and 54 for at least the same reasons discussed above with respect to the first anticipation rejection.

Applicant requests that the obviousness rejections be withdrawn for at least the above-stated reasons.

**G. Conclusion**

Applicant believes that the present document is a complete response to the Office Action. The present case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned attorney at (512) 536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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## **APPENDIX A**